



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/683,561	01/18/2002	Winnie C. Durbin	GEMS8081.123	1736
27061 7590 12/21/2006 ZIOLKOWSKI PATENT SOLUTIONS GROUP, SC (GEMS) 136 S WISCONSIN ST PORT WASHINGTON, WI 53074			EXAMINER SIMITOSKI, MICHAEL J	
			ART UNIT 2134	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			12/21/2006	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/683,561

Applicant(s)

DURBIN ET AL.

Examiner

Michael J. Simitoski

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22, 24-29 and 32 is/are rejected.
- 7) ☒ Claim(s) 23, 30 and 31 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. The response of 10/18/2006 was received and considered.
2. Claims 1-32 are pending.

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1-32 have been considered but are moot in view of the new ground(s) of rejection.
4. Applicant's response (p. 9) argues that claims 17-21 are now directed to statutory subject matter. However, a computing device data signal does not fall within one of the four statutory classes of invention.
5. Applicant's response (p. 14) argues that the references lack receipt, at a centralized facility, or a request to activate an option resident in memory of a remote stand-alone device from a user via a data entry module remote from the centralized facility and communicatively coupled with the remote stand-alone device. However, Steinmetz, as modified with Whigham, discloses a central server which validates and charges a user, generates a vend code and sends the vend code to the user, which as modified with Steinmetz, allows activation of an option. In the rejections, Rive is modified similarly.
6. Applicant's response (p. 18) argues that the transaction record of Whigham fails to disclose a user request. However, this limitation is not relied upon for this. The user dials a number (or various other identifying embodiments) which represents Whigham's request. Further, Steinmetz generates a key for a specific option, which means there must be a request for that option.

***Claim Objections***

7. Claim 5 is objected to because of the following informalities: “software should be replaced with software option”.
8. Claim 21 is objected to because “upon user” should be replaced with “upon the user” and “into memory” should be replaced with “into the memory”.

Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 17-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to a computing device data signal embodied on a carrier wave, which does not fall within one of the four statutory classes of invention under §101.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for

Art Unit: 2134

patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 17 & 19 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,672,505 to Steinmetz et al. (**Steinmetz**).

Regarding claim 17, Steinmetz discloses a computing device data signal embodied in a carrier wave and representing a sequence of instructions (inherent in that computers perform the steps in Steinmetz) to receive, at a centralized facility/licensing authority (col. 9, lines 31-34), a request to activate an option/configuration (col. 9, lines 31-34) resident in memory of a remote stand-alone device/ATM from a user (col. 16, lines 9-18) via a data entry module (keyboard of the device, col. 5, lines 14-25) remote from the centralized facility/licensing authority and communicatively coupled with the remote stand-alone device (col. 9, lines 54-64), determining whether the user is qualified (has paid) (col. 16, lines 9-18) and if so, grant access to the option resident in the remote stand-alone device (col. 9, lines 62-64) for a limited time period (col. 10, line 61 – col. 11, line 2), generate a software key (authorization key) designed to allow access to the option for the limited time period (col. 9, lines 31-44 & col. 10, line 61 – col. 11, line 2) and send the software key to the user (col. 9, lines 11-30).

Regarding claim 19, Steinmetz discloses wherein the sequence of instructions further comprises instructions to receive a user identifier (customer number, col. 4, lines 40-41), receive a system identifier (physical code, col. 4, lines 35-36), receive an option identifier (version number, col. 10, lines 62-66 or configuration ID, Fig. 5) and generate the software key to be specific to the user, the system and the option (col. 10, lines 13-18 & lines 57-58 & Fig. 5, #128).

***Claim Rejections - 35 USC § 103***

Art Unit: 2134

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-2, 20 & 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Steinmetz** in further view of U.S. Patent 6,490,684 to Fenstermaker et al. (**Fenstermaker**).

Regarding claim 1, Steinmetz discloses receiving a request and I.D. data (customer ID, Fig. 5) from a user via a data entry module (device's keyboard, col. 5, lines 14-25) communicatively coupled with a remotely located stand-alone device (ATM, Fig. 5) seeking access to a non-enabled option resident on the device (ATM, col. 9, lines 56-60), generating an electronic enabler (authorization key, col. 9, lines 33-34) to enable the non-enabled option (col. 9, lines 62-64), transmitting the electronic enabler to the user (documents, col. 11, lines 66-67), providing instructions to the user (documents describing key, col. 11, lines 66-67) to install the electronic enabler in the remotely located stand-alone device to activate the option on the remotely located stand-alone device (ATM, col. 9, lines 56-60). Steinmetz lacks receiving the I.D. and request from and transmitting the electronic enabler and instructions via the data entry module remote from the stand-alone device. However, Whigham teaches a vending system where the user uses a cellular phone to request and purchase a product from a machine (col. 4, lines 10-14) that is received by a server/centralized facility (col. 4, lines 10-14), which then automatically delivers a vend code to the user (col. 4, lines 53-61) and can be transmitted to the machine (col. 4, lines 65-67). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Steinmetz to allow the user to be remote

Art Unit: 2134

from the centralized facility and the remote stand-alone device and to send the request for the authorization key and receive the key from the data entry module (phone). One of ordinary skill in the art would have been motivated to perform such a modification to eliminate the need for a dedicated online connection between the remote stand-alone device and the licensing authority, as taught by Whigham (col. 4, lines 10-14, lines 53-67 & col. 7, lines 43-47). As modified, Steinmetz lacks the device being a medical imaging scanner. However, Fenstemaker teaches that it is beneficial for users to try certain features of an ultrasound device without adding any hardware (col. 1, lines 21-32). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to selectively enable options on a medical imaging device. One of ordinary skill in the art would have been motivated to perform such a modification because there is a need in the art to do so, as taught by Fenstemaker (col. 1, lines 21-32).

Regarding claim 2, Steinmetz discloses the step of enabling user access to the option for a predefined period of time (col. 10, line 61 – col. 11, line 2).

Regarding claim 20, Steinmetz discloses an encrypted alphanumeric identifier (col. 5, lines 57-59), but lacks the device being a medical imaging scanner. However, Fenstemaker teaches that it is beneficial for users to try certain features of an ultrasound device without adding any hardware (col. 1, lines 21-32). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to selectively enable options on a medical imaging device. One of ordinary skill in the art would have been motivated to perform such a modification because there is a need in the art to do so, as taught by Fenstemaker (col. 1, lines 21-32).

Regarding claim 21, Steinmetz discloses the software key (authorization key) being configured to activate the option upon (configuration, col. 3, lines 54-61) upon the user inputting of the alphanumeric code (authorization key) into the memory of the device via the data entry module (keyboard of the device, col. 5, lines 14-25 & Fig. 5).

15. Claims 10-12, 18 & 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Steinmetz** in further view of U.S. Patent 6,584,309 to **Whigham**.

Regarding claims 10 & 32, Steinmetz discloses a stand-alone device (ATM) having a data entry module (device's keyboard, col. 5, lines 14-25) communicatively coupled therewith and further including at least one disabled option (col. 9, lines 56-60) resident in memory thereon, but lacks a centralized facility, as claimed. However, Whigham teaches a centralized facility (server, col. 4, lines 10-14) located remotely from the device and having at least one computer (cellular phone) programmed to display (send vend code) a graphical user interface (cellular phone or PDA) (col. 5, lines 33-37) configured to facilitate user activation of the at least one disabled option (col. 5, lines 38-43), receive a request to activate the disabled option from a user remote from the device (vending machine) and the centralized facility (server) (Fig. 1), generate an alphanumeric code (vend code, col. 4, lines 53-61) and electronically transmit the alphanumeric code (vend code) to the user (col. 4, lines 53-61), the alphanumeric code configured to activate the disabled option upon inputting of the alphanumeric code by the user on the data entry module (ATM or vending machine keypad, col. 5, lines 14-25) communicatively coupled with the stand alone device (vending machine). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Steinmetz to



Art Unit: 2134

send the request for the authorization key and receive the key from the data entry module (cellular phone). One of ordinary skill in the art would have been motivated to perform such a modification to eliminate the need for a dedicated online connection between the remote stand-alone device and Steinmetz's licensing authority, as taught by Whigham (col. 4, lines 10-14, lines 53-67 & col. 7, lines 43-47).

Regarding claim 11, Steinmetz, as modified above, teaches wherein the at least one computer (Whigham's cellular phone) display the alphanumeric code on the graphical user interface (col. 4, lines 53-61 & col. 5, lines 26-37).

Regarding claim 12, Steinmetz discloses wherein the alphanumeric code (authorization key) is further configured to activate the disabled option for a predetermined and limited time period (expiration period, col. 10, line 61 – col. 11, line 2).

Regarding claim 18, Steinmetz lacks the data entry module comprising a computer remote from the stand-alone device, wherein the sequence of instructions comprises instructions to display the software key (authorization key) on a graphical user interface accessible by the user from the computer remote from the centralized facility and remote from the stand-alone device. However, Whigham teaches a vending system where the user uses a cellular phone to request and purchase a product from a machine (col. 4, lines 10-14) that is received by a server/centralized facility (col. 4, lines 10-14), which then automatically delivers a vend code to the user (col. 4, lines 53-61) and can be transmitted to the machine (col. 4, lines 65-67).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Steinmetz to allow the user to be remote from the centralized facility and the remote stand-alone device. One of ordinary skill in the art would have been

Art Unit: 2134

motivated to perform such a modification to eliminate the need for a dedicated online connection between the remote stand-alone device and the licensing authority, as taught by Whigham (col. 4, lines 10-14, lines 53-67 & col. 7, lines 43-47).

16. Claims 13, 22, 24 & 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Steinmetz, Whigham & Fenstermaker**.

Regarding claim 13, Steinmetz discloses wherein the alphanumeric code is configured to automatically disable the activated option upon expiration of the predetermined and limited time period (col. 10, line 61 – col. 11, line 2), but lacks the stand-alone device being a medical imaging scanner. However, Fenstermaker teaches that it is beneficial for users to try certain features of an ultrasound device without adding any hardware (col. 1, lines 21-32). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to selectively enable options on a medical imaging device. One of ordinary skill in the art would have been motivated to perform such a modification because there is a need in the art to do so, as taught by Fenstermaker (col. 1, lines 21-32).

Regarding claim 22, Steinmetz discloses activation of a disabled option resident on a device (col. 9, lines 62-64), receiving a number of user inputs (col. 10, lines 1-13), generating an alphanumeric code (authorization key, col. 10, lines 14-15) to activate the disabled option upon inputting of the alphanumeric code by the user on a data entry module (device's keyboard, col. 5, lines 14-25) communicatively coupled with the device (col. 5, lines 14-25), but lacks displaying a graphical user interface configured to facilitate activation, automatically conveying the generated alphanumeric code to the user and the device specifically being a medical imaging

Art Unit: 2134

device. However, Whigham teaches a vending system where the user uses a cellular phone to request and purchase a product from a machine (col. 4, lines 10-14) that is received by a server/centralized facility (computer readable storage medium having a computer program with instructions that when executed ..., col. 4, lines 10-14), which then automatically delivers a vend code to the user (col. 4, lines 53-61) and displays a graphical user interface configured to facilitate activation a service (cellular phone, col. 5, lines 26-37) where the user inputs the alphanumeric code (vend code) into the device (vending machine) via a data entry module (keypad, col. 5, lines 26-37). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Steinmetz to include a computer readable medium (server) to display a graphical user interface (send Steinmetz's authorization key to a cellular phone) and to send automatically send the authorization key from the data entry module (cellular phone). One of ordinary skill in the art would have been motivated to perform such a modification to eliminate the need for a dedicated online connection between the remote stand-alone device and the licensing authority, as taught by Whigham (col. 4, lines 10-14, lines 53-67 & col. 7, lines 43-47). As modified, Steinmetz lacks the device being a medical imaging device. However, Fenstemaker teaches that it is beneficial for users to try certain features of an ultrasound device without adding any hardware (col. 1, lines 21-32). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to selectively enable options on a medical imaging device. One of ordinary skill in the art would have been motivated to perform such a modification because there is a need in the art to do so, as taught by Fenstemaker (col. 1, lines 21-32).

Regarding claim 24, Steinmetz discloses instructions causing the computer to determine a period of delay (expiration parameter), the period of delay representing a time to allow the user to activate the disabled option (col. 10, line 66 – col. 11, line 2).

Regarding claim 26, Steinmetz discloses instructions causing the computer to determine a period of delay, the period of delay representing a time to allow the user to activate the disabled option (col. 10, line 66 – col. 11, line 2), but lacks the period of delay being 24 hours. However, absent any showing of criticality, it would have been obvious to choose the expiration period to be 24 hours.

17. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Steinmetz, Whigham & Fenstermaker**, as applied to claim 24 above, in further view of **Castagna**.

Regarding claim 25, Steinmetz, as modified above, lacks emailing an electronic request to the user upon expiration of the period of delay. However, Castagna teaches that demoware is a limited version of a commercial vendor's application you try for a time before it disables (p. 2, ¶3) and that when downloading the application, an email address is collected so the vendor can follow up and try to sell the user the full version (p. 2, ¶5). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Steinmetz to transmit a request for verification of enablement via email. One of ordinary skill in the art would have been motivated to perform such a modification to follow up with the user to entice a user to purchase the option, as taught by Castagna (p. 2).

Art Unit: 2134

18. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Steinmetz, Whigham, Fenstemaker & Castagna**, as applied to claim 25 above, in view of U.S. Patent 6,795,703 to Takae et al. (**Takae**). Steinmetz, as modified above, lacks further causing the computer/licensing authority to automatically accept a verification email from the user verifying self-activation of the disabled option. However, Takae teaches that if a verification email is accepted from a user who has just activated a handset, the verifier is assured that the activation was successful without visiting a particular location (col. 5, lines 5-25 & lines 42-49). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Steinmetz's licensing authority to automatically accept a verification email from the user verifying self-activation. One of ordinary skill in the art would have been motivated to perform such a modification to inform the licensing authority that the activation was successful without visiting a particular location, as taught by Takae (col. 5, lines 5-25 & lines 42-49).

19. Claims 1-2, 4-5, 7-9, 16-17 & 20-21, are rejected under 35 U.S.C. 103(a) as being unpatentable over **Rive, Whigham & Fenstemaker**

Regarding claims 1, 7 & 17, Rive discloses receiving a request and I.D. data from a user (request from a specific user) of a remotely located stand-alone device (client, col. 16, lines 44-49 & col. 17, lines 32-36) seeking access to a non-enabled option resident on the device (col. 17, lines 37-43), generating an electronic enabler (one-time password, col. 17, lines 49-55) configured to enable the non-enabled option (col. 17, lines 49-55), transmitting the electronic enabler to the user and providing instructions to the user to install the electronic enabler (one-

Art Unit: 2134

time password) in the remotely located stand-alone device (client) to activate the option on the remotely located stand-alone device (col. 17, lines 48-55). Rive lacks the request being received specifically from a data entry module remote from and communicatively coupled with the stand-alone device and lacks providing the instructions and enabler to the user via the data entry module. However, Whigham teaches a vending system where the user uses a cellular phone (data entry module) to request and purchase a product from a machine (col. 4, lines 10-14), the request being received by a server/centralized facility (col. 4, lines 10-14), which then automatically delivers a vend code to the user, via the phone (data entry module, col. 4, lines 53-61) and can be transmitted to the machine (col. 4, lines 62-67). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Rive to receive a request to enable from and send the instructions and an electronic enabler to the user's phone, remote from and communicatively coupled to the stand-alone device. One of ordinary skill in the art would have been motivated to perform such a modification to eliminate the need for a dedicated online connection between the remote stand-alone device and the, as taught by Whigham (col. 4, lines 10-14, lines 53-67 & col. 7, lines 43-47). Rive, as modified above, lacks the device being a medical imaging device. However, Fenstemaker teaches that it is beneficial for users to try certain features of an ultrasound device without adding any hardware (col. 1, lines 21-32). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to selectively enable options on a medical imaging device. One of ordinary skill in the art would have been motivated to perform such a modification because there is a need in the art to do so, as taught by Fenstemaker (col. 1, lines 21-32).

Regarding claim 2, Rive discloses enabling access for a predetermined period of time (renting, col. 16, lines 37-41 & lines 62-67).

Regarding claim 4, Rive, as modified above, teaches providing the electronic enabler (Rive's one-time password, Whigham's vend code) via a telephone system (cellular phone) coupled with the data entry module (phone, Fig. 1, #122).

Regarding claim 5, Rive, as modified above, discloses granting a license (Rive's one-time password, Whigham's vend code) to use the software option for a predetermined trial period (col. 16, lines 37-41 & lines 62-67).

Regarding claim 8, Rive discloses generating the electronic enabler upon user satisfaction of a user account (profile, col. 16, lines 43-46).

Regarding claim 9, Rive discloses a centralized facility (supplier, col. 17, lines 38-44), as modified, shows a data entry module (cellular phone) remote from the centralized facility and communicatively coupled with the remotely located stand-alone medical imaging device (Fig. 1), wherein the step of receiving a request includes the step of receiving the request at a centralized facility (supplier, col. 17, lines 38-44) via a graphical user interface (cellular phone) accessed by the user at the workstation (cellular phone) remote from the centralized facility (Fig. 1).

Regarding claim 16, Rive discloses electronically transmitting an instructional manual to the user (instructions), the manual including a set of instructions for activating the disabled option (col. 17, lines 48-55).

Regarding claims 20-21, Rive, as modified above, lacks the alphanumeric code being encrypted. However, Fenstermaker teaches that encrypting an authorization key reduces the likelihood of unauthorized use of a feature/option (col. 5, lines 1-3). Therefore, it would have

Art Unit: 2134

been obvious to one having ordinary skill in the art at the time the invention was made to modify Rive to encrypt the software key. One of ordinary skill in the art would have been motivated to perform such a modification to reducing reduce the likelihood of unauthorized use of a feature/option, as taught by Fenstemaker (col. 5, lines 1-3).

20. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Rive, Whigham** and **Fenstemaker**, as applied to claim 2 above, in further view of U.S. Patent Application Publication 2001/0034712 to **Colvin**. Rive explicitly lacks enabling access for a trial period of thirty days. However, Colvin teaches a system where software is provided use in an authorization interval, which requires a password for continued use for another interval, where the authorization interval is based on a calendar or date and corresponds to 30 days (§50). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Rive to enable the software for a trial period of thirty days. One of ordinary skill in the art would have been motivated to perform such a modification because the interval is based on a calendar, which allows for easier management and monitoring.

21. Claims 6 & 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Rive, Whigham** and **Fenstemaker**, as applied to claims 1 & 10 above, in further view of “Something for Nothing – Phone for free, save on books, or build a home page on the house. The Web offers an abundance of free stuff-but watch out for strings” by **Castagna**. Rive, as modified above, lacks emailing an electronic request to the user upon expiration of the period of delay. However, Castagna teaches that demoware is a limited version of a commercial vendor’s application you



Art Unit: 2134

try for a time before it disables (p. 2, ¶3) and that when downloading the application, an email address is collected so the vendor can follow up and try to sell the user the full version (p. 2, ¶5).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made transmit a request for verification of enablement. One of ordinary skill in the art would have been motivated to perform such a modification to follow up with the user to entice a user to purchase the option, as taught by Castagna (p. 2).

22. Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Rive** in view of **Whigham**.

Regarding claim 10, Rive discloses a stand-alone device (computer with deactivated option, col. 17, lines 38-44) having a data entry module (module to enter the one-time password, see col. 17, lines 52-55) communicatively coupled therewith and further including at least one disabled option resident in memory thereon (col. 17, lines 38-44), but lacks a centralized facility as claimed. However, Whigham teaches a vending system (similar to Rive's computer with deactivated option) where the user uses a cellular phone to request and purchase a product from the vending machine (col. 4, lines 10-14), where a request is received by a server/centralized facility (col. 4, lines 10-14), which then automatically generates and transmits a vend code to the user, via the phone (graphical user interface, col. 4, lines 53-61) and where the user inputs the vend code into the vending machine via a data entry module (col. 5, lines 26-37). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Rive to receive a request to enable from and send an alphanumeric code to a user's phone, remote from the stand-alone device. One of ordinary skill in the art would have

Art Unit: 2134

been motivated to perform such a modification to eliminate the need for a dedicated online connection between the remote stand-alone device and the, as taught by Whigham (col. 4, lines 10-14, lines 53-67 & col. 7, lines 43-47).

Regarding claim 11, Rive, as modified above, discloses that the at least one computer (centralized facility) is programmed to display the alphanumeric code (Rive's one-time password, Whigham's vend code) on the graphical user interface (user's cellular phone, Whigham col. 5, lines 26-37).

Regarding claim 12, Rive, as modified above, discloses wherein the alphanumeric code is further configured to activate the disabled option for a predetermined and limited time period (renting, col. 16, lines 37-41 & lines 62-67).

23. Claims 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Rive**, **Whigham**, and **Fenstermaker**, as applied to claim 1 above, in view of U.S. Patent 5,708,709 to **Rose**. Rive, as modified above, lacks conveying a follow up message to the user prior to an expiration of a trial period for which the user is enabled access. However, Rose teaches that a soft expiration date, where the user is warned that at the a future termination date, the user will need to obtain a licensed copy of an application program (col. 11, lines 16-23), avoids suddenly preventing use of the application and ensures the user is warned of expiration (col. 11, lines 23-34). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to convey a follow up message to the user prior to the expiration of a trial period. One of ordinary skill in the art would have been motivated to perform such a

Art Unit: 2134

modification to avoid suddenly preventing use of the application and ensure the user is warned of expiration, as taught by Rose (col. 11, lines 16-34).

*Allowable Subject Matter*

24. Claims 14, 23 & 30-31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

25. The following is a statement of reasons for the indication of allowable subject matter:

a. Regarding claim 14, the prior art relied upon fails to teach or suggest the at least one computer programmed to prompt the user to input a set of identifying data, generate an electronic licensing contract and prompt the user to accept or decline, in combination with the remaining limitations of the claim.

b. Regarding claim 23, the prior art relied upon fails to teach or suggest wherein the instruction to convey the alphanumeric code includes one of emailing the alphanumeric code to the user via an electronic messaging system and displaying the alphanumeric code on the graphical user interface coupled with the data entry module, in combination with the remaining elements of the claim. The prior art teaches wherein the code is displayed and entered by the user and wherein the code is transmitted, but not the code is displayed on the interface coupled with the data entry module.

c. Regarding claims 30-31, the prior art relied upon fails to teach or suggest receiving the request to activate the disabled option from the user from the device and the centralized facility initiated by the user from the data entry module in a remote link that

Art Unit: 2134

links the centralized facility to the stand-alone device, in combination with the remaining elements of the claims.

### *Conclusion*

26. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Simitoski whose telephone number is (571) 272-3841. The examiner can normally be reached on Monday - Thursday, 6:45 a.m. - 4:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (571) 272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

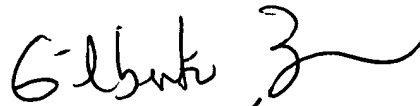
Art Unit: 2134

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJS



December 13, 2006



GILBERTO BARRON JR  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100